**IN THE UNITED STATES PATENT OFFICE**

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| In Re Patent Application of: | ) | |
| | ) | Examiner: Chang, Kent Wu |
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| Webb et al. | ) | Art Unit: 2675 |
| | ) | |
| Application No. 09/932,213 | ) | |
| | ) | |
| Filed: August 17, 2001 | ) | |
| | ) | |
| For: A MOBILE DEVICE HAVING MOVEABLE SEGMENTS THAT CAN BE ADJUSTED TO AFFECT AN OVERALL LENGTH (AS AMENDED) | ) | |

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

## REPLY BRIEF

Dear Sir/Madam:

In response to the Examiner's Answer mailed April 18, 2007 (the "Examiner's Answer), Applicant submits this Reply Brief to Examiner's Response. This Reply Brief is to supplement Applicant's first Appeal Brief dated January 16, 2007. No amendments are being filed herewith.

## STATUS OF CLAIMS

Claims 1-50 are pending. Each pending claim stands rejected and each rejection is appealed.

## GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Applicant respectfully requests review of whether claims 1-50 are rendered obvious under 103(a) by U.S. Patent No. 6,542,721 to Boesen ("Boesen") as held in the Final Office Action.

**ARGUMENT**

Applicant submits this Reply Brief to address arguments made in the Examiner's Answer of April 18, 2007. As this Reply Brief is being filed within two months of the Examiner's Answer, consideration of this Reply Brief is a matter of right. This Reply Brief is intended only to supplement Applicant's Appeal Brief dated January 16, 2007, and is ***not*** intended to be a replacement for that brief.

Applicant believes that the Examiner's application of Boesen to the pending claims is off-point. Applicant submits that Claims 1-50 each include one or more limitations not disclosed by Boesen and therefore are not obvious in view of Boesen.

In rejecting Claim 1, the Examiner incorrectly argued that

> "...***Figure 7 [illustrates], the PDA portion (28) is housed inside of the cellular transceiver portion (4) while in the contracted position***, and can be moved out to an extended position by sliding movement only, then can be pivoted to allow the user to adjust the angle between the cellular transceiver portion and the PDA portion (note that a portion of the slide hinge 41 is inside of the cellular transceiver portion as shown by the dotted lines in Figure 7)" (Examiner's Answer, page 7, lines 11-16, emphasis added).

In fact, in Boesen, the "PDA Portion (28)" is **not housed inside** the "cellular transceiver portion (4)" as the Examiner argues. The issue as to whether the "PDA Portion (28)" is or is not housed within the "cellular transceiver portion (4)" is the primary point of contention between Applicant and the Examiner.

If the Board agrees with Applicant on this point, then Applicant submits that the claims should be allowed. This conclusion follows because, under Applicant's reading of Boesen, the device disclosed therein has (i) an extended position where the "PDA Portion (28)" and the "cellular transceiver portion (4)" are side-by-side and flat, and (ii) a contracted position with the "cellular transceiver portion (4)" positioned on top of the

"PDA Portion (28)". Applicant's argument is that all Applicant's claims require "movement primarily along one axis, without pivoting…", and that Boesen's device requires a pivot to move from the contracted position to the extended position. The Examiner's position is that there is an alternative contracted position taught by Boesen, where the "PDA Portion (28)" is housed within the "cellular transceiver portion (4)" of the device. With this interpretation, the Examiner is saying a pivot would not be required to manipulate the Boesen device between the extended and contracted position. Thus, the point of contention.

What Boesen shows in Figure 7 is a "slide hinge" extending from the "PDA Portion (28)" and embedded within the housing of the "cellular transceiver portion (4)". Despite the Examiner's arguments to the contrary, this is not a teaching that the "PDA Portion (28)" is housed within the "cellular transceiver portion (4)". It is simply a showing of the two segments pivotally connected to one another, using a hinge. The "slide hinge" or point of contact between the two housing segments is what is embedded in the side-walls of the "cellular transceiver portion (4)". The slide hinge embedded in the "cellular transceiver portion (4)" allows the pivot connection, but there is no basis to conclude that the connecting structure would permit a pure sliding motion where one segment could be housed within the other segment.

Nowhere in Boesen is there a teaching that the "PDA Portion (28)" is housed within the housing of the "cellular transceiver portion (4)". All the figures teach the "PDA Portion (28)" is outside of the "cellular transceiver portion (4)". The language in the specification is consistent only with the view that the "cellular transceiver portion (4)" is positioned on top of the "PDA Portion (28)" in the contracted position.

Consider that Boesen provides for a "slide hinge (41) [that] allows the cellular transceiver portion of the personal electronic device to ***slide past*** the PDA portion of the personal electronic device" (Boesen, col. 5, lines 29-32). No mention is made at all with reference to Figure 7, or anywhere else in the specification, that the PDA portion can slide within, or is housed inside of, the cellular transceiver portion.

The Examiner also stated in the Examiner's Answer that "the pivoting movement [of

the slide hinge] is independent of the sliding movement and can only be performed after the PDA portion has completely moved out to the extended position…" (Examiner's Answer, page 7, line 18 – page 8, line 2). This teaching is not from Boesen, but is the result of the viewpoint that the "PDA Portion (28)" is housed within the "cellular transceiver portion (4)". Boesen teaches the use of hinges or other pivoting mechanisms (e.g. slide hinge) throughout the specification, none of which teach a pivotable mechanism that is independently operable of the sliding operation. By definition, a hinge pivots, and the use of the word "slide" (i.e. "slide hinge") does not change this fact.

The Examiner also argued that "Boesen teaches numerous embodiments to enable the opening and closing of the two segments as illustrated in Figures 5-15, wherein the structure and operation are completely different in these embodiments" (Examiner's Answer, page 7, lines 8-11). To the contrary, all of the embodiments shown in Figures 5-15 of Boesen show a contracted position where one segment is positioned on top of another segment (e.g. "cellular transceiver portion (4)" positioned over "PDA Portion (28)"). None of the embodiments shown in the figures or described in the specification support the Examiner's position that the "PDA Portion 28" slides into the "cellular transceiver portion (4)" of the Boesen device.

Applicant would like the Board to consider that the teaching of Boesen accompanying FIGS. 13-15 is illuminative of Boesen's teaching accompanying FIG. 7. In describing how the FIG. 7 device moves from a closed position to an open position, similar language is used to describe how the device of FIGS. 13-15 moves from a closed position to an open position. In FIG. 13, "the personal electronic device is shown in a closed position" (Boesen, col. 6 lines 54-55). As illustrated in FIG. 13, the "cellular transceiver portion (4)" is positioned over the "PDA portion (28)".

Additionally, in describing FIG. 7 in a closed position, Boesen states, "[t]his configuration also permits the PDA display or touch screen to be protected when in a closed position (Boesen, col. 5, lines 33-35). Under Examiner's interpretation of Boesen, the "PDA Portion (28)" would need to be housed within the "cellular transceiver portion (4)". Such an interpretation would be a big extrapolation, considering the lack of

description or teaching provided in Boesen for enabling the "cellular transceiver portion (4)" to accommodate the housing of the "PDA Portion (28)". A much more reasonable interpretation that is consistent with the other embodiments is that the "cellular transceiver portion (4)" pivots over the "PDA Portion (28)".

There are numerous other instances in Boesen where descriptive language supports Applicant's position. In describing the sliding motion as shown in FIGS. 14 and 15 to move the device from a closed position to an open position Boesen states, "…once the telephone transceiver portion has been ***slid past*** the adjustment mechanism…" (Boesen, col. 6, lines 60-63; see also; col. 6 line 63 – col. 7 line 2, discussing "slid past" and "upwardly slide along", and Claim 1 stating "wherein the second body travels out and away from and over a top portion of the touch screen display"). In describing the embodiment of FIG. 7 moving from a closed position to an open position, Boesen states, "The slide hinge (41) allows the cellular transceiver portion of [the] personal electronic device to ***slide past*** the PDA portion of the personal electronic device…" (Boesen, col. 5, lines 29-32). Use of the same language in describing how different embodiments, as shown in FIG. 7, and FIGS. 13-15, move from a closed position to an open position indicate that both embodiments, although visually distinctive, mechanically operate in a similar fashion.

Applicant would also like the Board to consider that the Examiner's rational is only appropriate under an inherency standard. In making the statement that "***the PDA portion (28) is housed inside of the cellular transceiver portion (4) while in the contracted position"***, the Examiner is inferring that Boesen's device has a particular inherent functionality (which Applicant disputes). Under the inherency standard, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. (In re Rijckaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); In re Oelrich, 212 USPQ 323, 326 (CCPA 1981)). To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter (i.e. one segment housed within another) is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a

certain thing may result from a given set of circumstances is not sufficient (In re Robertson, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999); see also MPEP §2112 IV).

For reasons stated herein and in Applicant's first Appeal Brief dated January 16, 2007, Applicant submits that Boesen fails to teach or suggest features of Applicant's pending claims. Because Boesen fails to recite at least the above recited limitations, Boesen does not render Claim 1, nor Claims 2–18, which depend from and further limit Claim 1, obvious.

With respect to independent Claims 19 and 27, Applicant reiterates the arguments made above with respect to Claim 1 and submits that Boesen does not disclose or suggest a second segment slideably coupled to the first segment to move, without pivoting, between a contracted position and an extended position. As Claims 20-26 and Claims 28-40 depend from Claims 19 and 27 respectively, Claims 20-26 and 28-40 are allowable for the reasons stated.

With respect to Claims 41 and 45, Applicant reiterates the arguments above as stated with respect to Claim 1 and submits that Boesen does not disclose "a second segment slideably coupled to the first segment to move primarily along one axis, without pivoting, between a contracted position and an extended position." Applicant submits that the device described by Boesen in Figure 7 does not disclose or suggest a first and second segment that move primarily on one axis, without pivoting, between a contracted position and an extended position. As Claims 42-44 and Claims 46-50 depend from Claims 41 and 45 respectively, Claims 42-44 and 46-50 are allowable for the reasons stated.

***CONCLUSION***

For at least the foregoing reasons, applicant submits that pending claims 1-50 are not anticipated by Boesen and respectfully requests that their rejection be overturned.

**AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

Please charge deposit account 50-1914 for any underpayments in connection with this Office Action response.

Respectfully submitted,
Shemwell Mahamedi LLP

Date: June 18, 2007

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